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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,127	03/23/2004	Akira Hirose	119191	2111
25944	7590	12/31/2007		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER VO, TED T	
			ART UNIT 2191	PAPER NUMBER
			MAIL DATE 12/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/806,127

Applicant(s)

HIROSE ET AL.

Examiner

Ted T. Vo

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2007.
- 2a) ☒ This action is **FINAL**.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-16 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/16/06, 6/22/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the communications filed on 09/25/2007.

Claims 5-16 are pending in the application.

Response to Arguments

2. This is in response to the argument and amendment to the claims filed on 09/25/2007.

-With regards to claims rejected under 35 USC 112, second paragraph, Applicants fail to identify or explain what is "instruction form" used in the claims.

- With regards to the argument to the claims rejected under 35 USC 101, the argument is not persuasive. The claims show no connections with hardware, but software elements.

-With regards to claims rejected under 102(a) being anticipated by Watters, Applicants argued that the Watters fails to teach deletion by reasoning that the submit button does not correspond to the claimed deletion part because Watters' form is not cleared when the button is clicked. Applicants argued that when Watters' submit button is clicked, the completed form is sent back to the server source, it does not support the submit button deletes the form from the storage and from one of the plurality of instruction from execution when the process indicated the instruction form has been completed. Applicants also argued that the reset button to clear the form renders the teaching inapplicable to the subject matter of the claimed, by reasoning that it requires the user to perform additional step of clicking button.

Examiner responds:

The claims have been ambiguous in describing the functionality of an action. It should be noted that submitting a form or deleting form's content has been used commonly in the art. In order to make the novelty from such a common feature, it requires the argument point out the patentability of the feature under 1.111(c).

The claims are unable to define clearly "instruction form". As being understood from the Applicants' argument, deletion of a form is that it is without requiring the additional step shown in Watters' form using a reset button. Therefore, it appears the Applicants' argument admitted that the original form without user input and the submitted form with user input are two different subject matters. And the requirement of the additional step the Watters unclearly show whether or not the form back to blank after the click of submit button.

By these reasons of the Applicants' arguments, Examiner contends that the feature deletion used in the claims could not present a patentable feature; it is a feature of public domain and is common in the web; particularly, it uses available commands, instructions that were developed for the purpose of cleanup data in the memory. Such instructions/data can be seen in Java script instructions or other programming languages. Even the deletion of an instruction form, before or after a completion, it does not a patentable difference. It should be noted that the deletion is inherently provided by every PDA or personal computer using with the form submission. Walters if it does not mention the word "deleting" because the deletion is part of the form submission. If there is no deletion as in Applicants' argument, forms will pile up in the computer memory after every submission, and thus it makes a PDA useless.

The anticipation by a prior art is proper if the prior art reference discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992).

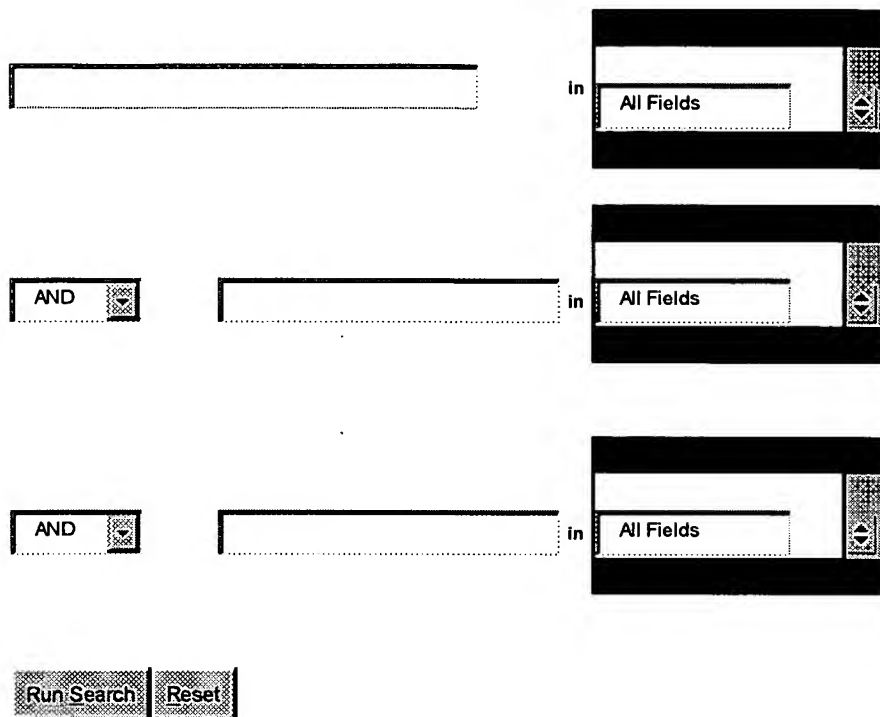
In this claimed matter, the deletion is inherently disclosed in every prior art that uses form submission.

For example, in the IEEE search:

OPTION 1

Enter keywords or phrases, select fields, and select operators

 Help



The screenshot displays the IEEE search interface. It features a main search bar at the top. Below it, there are three rows of input fields. Each row starts with a dropdown menu containing the word "AND". This is followed by a text input field for keywords. To the right of the keyword field is a small "in" label, followed by another dropdown menu currently set to "All Fields". At the bottom of the form, there are two buttons: "Run Search" and "Reset". A "Help" link with a question mark icon is located in the top right corner.

After filling search query and click Run search, the above form with search query is cleared and the search provides search results. When user attempts to get the search form again, it will bring back with an original blank form as shown above. IEEE does not say "deletion", but the original form by itself tells the means for deleting.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to the recitations in the claims' independents, the recitations are ambiguous. The claim recites "**instruction form**", where both the specification and the claims fail to indicate a clear meaning of "instruction form". This is an ambiguity of the claims in term of deletion since it does not know the form is as an original template or not. Since the deletion of an original template means that a user cannot get it back after deletion.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The claims 5-16 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

As per Claims 5-7: The claims recite "an instruction form management apparatus". The claims asserts with "a storage that stores an instruction form". However, the claim links to no hardware entities. The storage as claimed does not show the instruction form management apparatus as a hard ware element. The storage covers a software element, such as a file added with user input parameters filled from the text areas.

As per Claims 8-10: As the same reason as of the claims 5-7, the claims 8-10 recite an instruction form management system without connecting to a hardware element. The claims are further added with "connected via a network". However, the term "a network" implicitly covers a general entity of an environment, where this environment is not necessary as a cluster of computers. Therefore, system remains covering the software per se.

As per Claims 11-13, and 14-16: The claims clearly cover the software per se because no links to hardware elements.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 5-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Oracle, "Oracle9i Case Studies – XML Applications", June 2001.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 5: ORACLE discloses,

An instruction form management apparatus comprising (See p. 8-30, Figure 8-5: Section Retailer):

a storage that stores an instruction form that indicates a process (Oracle provides a creation of Build

the Retailer and Supplier Schema. See Retailer Database R (Figure 8-5), when user invokes a XML Order, it simply uses login, and user enters information in the order form, data information will store in an ORD table) **to be executed to a document by at least one of a plurality of instruction form execution apparatuses connected to the instruction form management apparatus via a network** (i.e. the form that provides the user to submit with filled-in order, Quantity = 1, as shown in p.8-44, Figure 8-13);

an output part that outputs the instruction form to the at least one of the plurality of instruction form execution apparatuses (See Figure 8-5, i.e. the XML order from Retailer Database R, this XML order is filled in by user, and transformed by XSQL Servlet into the "XML order", then sent to Supplier by the user' click on the "Place Order"); and

a deletion part that causes the instruction form to be deleted from the storage and from the at least one of the plurality of instruction form execution apparatuses when the process indicated in the instruction form has been completed (See p.8-34 and 8-35, from step 1 to step 8, where in the step 8, after the user clicks on "Place Order" the form is submitted to the supplier, and the PDA of the user computer automatically clearly the user' query as the quantity = 1, by placing New Order Status to the retailer as shown in 8-48, Figure 8-16. In order to do repeating place order, user has to login again, and the original form is regenerated from the Retailer Database R. Further see p.3-27, Deletion feature is added in the script to clean up the database.

As per claim 6: Oracle discloses,

The instruction form management apparatus according to claim 5, further comprising a determination part that determines whether or not the instruction form includes information to delete the instruction form when the at least one of the instruction form execution apparatuses completes execution of the process indicated in the instruction form, wherein the deletion part deletes the instruction form if the instruction form includes the information to delete the instruction form.

See all the Figures 8-15 and 8-16, the Figures show the returns with result of completion or provided the user with the validation or cancel. Figure 8-16 also shows the Order Form filled with the user input no longer in the Retailer Database R. It should be noted that the deletion does not present a patentable feature because it is used in open source.

As per claim 7: Oracle discloses,

The instruction form management apparatus according to claim 6, wherein the information to delete the instruction form indicates that the instruction form is executed only once.

The figures show that in order to execute the Order Form again, the user must login and fill with new order.

As per Claims 8-10, 11-13, 14-16: Oracle discloses the claimed limitations because the claims have the functionality in the same manner as the functionality as recited in Claims 5-7.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

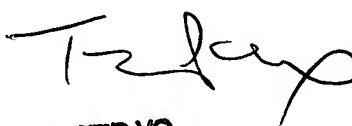
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV
December 21, 2007


TED VO
PRIMARY EXAMINER